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09/930,418	08/15/2001	Lawrence P. Bush	12016-205	1051

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EXAMINER

GOTTSCHALK, MARTIN A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* LAWRENCE P. BUSH
9

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11 Appeal 2009-000702
12 Application 09/930,418
13 Technology Center 3600
14

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16 Decided: December 4, 2009
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Lawrence P. Bush (Appellant) seeks review under 35 U.S.C. § 134
3 (2002) of a final rejection of claims 1-4, 6-20, and 26-29, which along with
4 claims 21-25 and 30-32 withdrawn from consideration, are the only claims
5 pending in the application on appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8 SUMMARY OF DECISION¹

9 We AFFIRM.

10 THE INVENTION

11 The Appellant invented a way of insurance claims adjustment utilizing a
12 card for payment of claims (Specification 1: Technical Field of the
13 Invention).

14 An understanding of the invention can be derived from a reading of
15 exemplary claim 1, which is reproduced below.

16 1. A method for administering insurance claims, comprising the
17 steps of:

18 (a) receiving a claim;

19 (b) determining a monetary value of said claim;

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed February 7, 2008) and Reply Brief ("Reply Br.," filed June 4, 2008), and the Examiner's Answer ("Ans.," mailed April 29, 2008).

- 1 (c) issuing a card representing an account;
2 (d) funding said account with at least a portion of said monetary
3 value;
4 (e) monitoring the activity of said account to obtain information
5 regarding usage of said card; and
6 (f) analyzing said information to determine trends in said usage
7 of said card.

8 THE REJECTIONS

9 The Examiner relies upon the following prior art:

Cherrington	5,717,595	Feb. 10, 1998
Rotman	2003/0018550 A1	Jan. 23, 2003
Slater	6,615,190	Sep. 2, 2003

10 Claims 1-4, 7-20, 26, 27, and 29 stand rejected under 35 U.S.C. § 103(a)
11 as unpatentable over Appellant's admitted prior art, Slater, and Rotman.

12 Claims 6 and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable
13 over Appellant's admitted prior art, Slater, Rotman, and Cherrington.

14 ARGUMENTS

15 The Appellant argues these claims as a group. Accordingly, we select
16 claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

17 The Appellant contends that none of the references describe limitation
18 (f) analyzing said information to determine trends in said usage of said card,
19 and that Rotman teaches away from analyzing a specific card. App. Br. 10-
20 15.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-4, 7-20, 26, 27, and 29 under 35 U.S.C. § 103(a) as unpatentable over Appellant's admitted prior art, Slater, and Rotman, turns on whether it was predictable to one of ordinary skill to analyze information to determine trends in using a card as in claim 1.

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 6 and 28 under 35 U.S.C. § 103(a) as unpatentable over Appellant's admitted prior art, Slater, Rotman, and Cherrington turns on the resolution of the first issue.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Slater

01. Slater is directed to stored value cards which are funded by a particular sponsor. Slater 1:5-7.

02. The cardholder may withdraw funds and receive information about the account. Slater 2:14-15.

03. A sponsor may request information about one or more stored value card accounts and Slater's system retrieves and transmits the information to a sponsor. Slater 5:23-29.

1 04. An insurance program permits an insurance company to pay
2 claimants and beneficiaries through a stored value card instead of
3 a conventional check. In this application, a card may be funded
4 one time or periodically, depending on the insurance agreement
5 and circumstances of the claim. Slater 7:25-30.

6 *Rotman*

7 05. Rotman is directed to compiling financial transaction data and
8 processing such data to provide financial information. Rotman ¶
9 0003.

10 06. Rotman describes a need in the art for the ability to make near
11 real-time market information predictions, including revenue trend
12 predictions, based on payment transaction information. Rotman ¶
13 0023.

14 07. Rotman provides near real-time market information predictions
15 based on money flow maps derived from payment transaction
16 information. Rotman meets the need for near real-time trend data
17 by leveraging the transactional data. Rotman ¶ 0024.

18 08. Rotman describes how sales information regarding
19 demographic trends may be marketed to merchants. Near real-time
20 predictions about the actual spending among a particular
21 demographic profile may be extremely valuable to retailers.
22 Rotman ¶ 0080.

1 *Facts Related to Appellant's Disclosure*

2 09. The Specification describes the existing practice of receiving an
3 insurance claim and determining the monetary amount of that
4 claim. Specification 2:1-9.

5 *Facts Related To The Level Of Skill In The Art*

6 10. Neither the Examiner nor the Appellant has addressed the level
7 of ordinary skill in the pertinent arts of systems analysis and
8 programming, insurance systems design, and financial transaction
9 systems design. We will, therefore, consider the cited prior art as
10 representative of the level of ordinary skill in the art. *See Okajima*
11 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
12 absence of specific findings on the level of skill in the art does not
13 give rise to reversible error ‘where the prior art itself reflects an
14 appropriate level and a need for testimony is not shown’”) (quoting
15 *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
16 F.2d 158, 163 (Fed. Cir. 1985).

17 *Facts Related To Secondary Considerations*

18 11. There is no evidence on record of secondary considerations of
19 non-obviousness for our consideration.

20 PRINCIPLES OF LAW

21 *Obviousness*

22 A claimed invention is unpatentable if the differences between it and
23 the prior art are “such that the subject matter as a whole would have been

1 obvious at the time the invention was made to a person having ordinary skill
2 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
3 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

4 In *Graham*, the Court held that that the obviousness analysis is
5 bottomed on several basic factual inquiries: “[(1)] the scope and content of
6 the prior art are to be determined; [(2)] differences between the prior art and
7 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
8 in the pertinent art resolved.” *Graham* 383 U.S. at 17. *See also KSR*, 550
9 U.S. at 406. “The combination of familiar elements according to known
10 methods is likely to be obvious when it does no more than yield predictable
11 results.” *Id.* at 416.

12 ANALYSIS

13 The Appellant has not contested whether steps (a)-(e) are described by
14 the prior art. As the Examiner found, steps (a) and (b) are described by the
15 admitted prior art (FF 09) and steps (c)-(e) are described by Slater (FF 01 -
16 04). Ans. 5-6. Thus, the sole issue is whether the art describes step (f) or
17 shows it was predictable.

18 The Examiner found that analyzing information to determine usage of an
19 item was notoriously well known and practiced, and offered Rotman as
20 evidence which described analyzing usage information of a card. Ans. 6.
21 As we found *supra*, the Appellant argues that Rotman only analyzes
22 aggregate usage, not individual card usage.

23 First, we find the facts discernable from a mere grammatical analysis of
24 this limitation. The limitation consists of analyzing information to determine
25 trends in said usage of a card. This limitation is that of analyzing

1 information. The objective of the analysis is nominally to determine usage
2 trends of the card, but this objective is not a limitation in scope per se, since
3 the step does not require such an outcome. In this, the objective directed
4 toward determining usage trends is aspirational rather than operational.
5 What is claimed is analysis, not the results of the analysis.

6 The step does not specify any particular analytical techniques. Thus any
7 analytic technique that might be applicable to determining usage trends for a
8 card, such as indexing data, would meet the limitation. In light of this, the
9 Examiner offered Rotman, which is quite rich in its use of analysis. For
10 example, Rotman describes making near real-time market information
11 predictions, including revenue trend predictions, based on payment
12 transaction information (FF 06) and near real time predictions marketed to
13 merchants based on actual card spending (FF 08). We find that this form of
14 analysis is highly pertinent to an analysis of individual card usage, whether
15 the analyst is actually pursuing that as an objective. Thus, this type of
16 analysis, which includes analysis for making predictions of card usage,
17 would be among those forms of analysis that would be predictable were the
18 analyst analyzing to determine trends in card usage. Further, such analysis
19 of at least a sample of individual card usage to confirm the validity of the
20 conclusions would be predictable at least to prove the validity of the overall
21 analysis.

22 The Appellant argues that Rotman describes analysis of aggregate data
23 rather than individual card data (App. Br. 11-12) and therefore teaches away
24 from the claim (App. Br. 13). But teaching an alternative is not discrediting.
25 *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“The prior art's
26 mere disclosure of more than one alternative does not constitute a teaching

1 away from any of these alternatives because such disclosure does not
2 criticize, discredit, or otherwise discourage the solution claimed in the [...]
3 application.”

4 CONCLUSIONS OF LAW

5 The Appellant has not sustained its burden of showing that the Examiner
6 erred in rejecting claims 1-4, 7-20, 26, 27, and 29 under 35 U.S.C. § 103(a)
7 as unpatentable over Appellant's admitted prior art, Slater, and Rotman.

8 The Appellant has not sustained its burden of showing that the Examiner
9 erred in rejecting claims 6 and 28 under 35 U.S.C. § 103(a) as unpatentable
10 over Appellant's admitted prior art, Slater, Rotman, and Cherrington.

11 DECISION

12 To summarize, our decision is as follows.

- 13 • The rejection of claims 1-4, 7-20, 26, 27, and 29 under 35 U.S.C. §
14 103(a) as unpatentable over Appellant's admitted prior art, Slater, and
15 Rotman is sustained.
- 16 • The rejection of claims 6 and 28 under 35 U.S.C. § 103(a) as
17 unpatentable over Appellant's admitted prior art, Slater, Rotman, and
18 Cherrington is sustained.

19 No time period for taking any subsequent action in connection with this
20 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

21
22 AFFIRMED
23
24

Appeal 2009-000702
Application 09/930,418

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2 mev

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